

REMARKS

Objections to the Specification

The Examiner has objected to the abstract for informalities. Applicant has amended the abstract as set forth above to comply with the 37 CFR §1.82 and MPEP 608.01(b). Accordingly, the Examiner's objections to the specification should be withdrawn.

Claim Rejections Under 35 U.S.C. § 112

Claims 13 and 14 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicant has amended claim 13 as set forth above to comply with 35 U.S.C. § 112, first paragraph. Claim 14 depends from claim 13 and therefore is also now in compliance with the enablement requirement. Accordingly, the Examiner's rejection of claims 13 and 14 under 35 U.S.C. § 112, first paragraph should be withdrawn.

Claim 20 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claim 20 as set forth above to correct the indefinite language identified by the Examiner. Accordingly, the Examiner's rejection of claim 20 under 35 U.S.C. § 112, second paragraph should be withdrawn.

Claim Rejections Under 35 U.S.C. § 102

Claims 11 and 12 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,424,035 to Hönes et al. (hereinafter "Hönes").

As set forth above, claim 11 is amended herein to clarify that the strip receiver includes two holding means for holding fast associated edges of the test strip substantially adjacent the support surface and a vertically displaced middle area such that a test strip inserted in the strip receiver is spaced apart from the support surface at the test area of the strip and substantially adjacent the support surface at the edges thereof.

Hönes discloses a test strip analysis system including an analysis apparatus with a test strip holding device and matching test strips. The holding device serves to position a test strip in a defined position relative to a measuring unit and includes a test strip seating device. As shown in Figure 3 of the Hönes patent, the test strip lies flat on the seating device.

Hönes does not teach a strip receiver as described in amended claims 11 and 12 having two holding means spaced from one another on edge areas of the support surface for holding fast associated edges of the test strip substantially adjacent the support surface, and a middle area of the support surface between the holding means being vertically displaced from the edge areas such that the test field of a test strip inserted in the strip receiver is spaced apart from the support surface.

To support an anticipation rejection under 35 U.S.C. § 102, a single prior art reference must disclose each and every element or limitation in the claim. As set forth above, Hönes does not teach or suggest each and every element of Applicant's claim 11 as amended herein. Therefore, the rejection of claim 11 under 35 U.S.C. § 102 cannot be maintained and should be withdrawn.

Claim 12 depends from claim 11 and specifically defines a projection which provides the vertical spacing of the test field from the support surface. Claim 12 is therefore likewise deemed not anticipated by Hönes. Accordingly, for at least the reasons set forth above, the rejections of claims 11 and 12 under 35 U.S.C. § 102(b) should be withdrawn.

Claims 15-17, 19 and 20 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable as obvious over U.S. Patent No. 4,780,283 to Meinecke et al. (hereinafter "Meinecke"). Meinecke shows a measuring device for measuring the test field of a longitudinally extending flexible test strip. The test strip has an insertion end to be inserted into the apparatus and a handling end. The test strip is securely held in a measurement position by a pin 28 penetrating recess 52 of the test strip. There is no clamping device clamping the test strip in the measurement position. At the handling end the test strip is held in a similar way by a pin 38 penetrating a recess 53 in the test strip.

Meinecke does not teach or suggest a pivotal clamping lever overlying the support surface and supported for movement about an axis parallel to the

support surface, the clamping lever including a clamping arm biased toward the support surface and engageable with a surface of the test strip opposite the support surface for securing the position of the test strip relative to the support surface as recited in Applicant's claim 15.

The Examiner admits that a pivotal clamping lever overlying the support surface as recited in Applicant's claim 15 is not disclosed in the Meinecke reference yet has rejected claim 15 under 35 U.S.C. § 103(a) stating that it would be obvious to one of ordinary skill in the art to modify the structure of Meinecke to include the structure of Applicant's claim 15 so that gravity could be utilized to aid in the clamping of the test strip.

The Examiner has not established the basic requirements of *prima facie* obviousness sufficient to maintain the rejection of Applicant's claim 15.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in references themselves or in the knowledge generally available to one of ordinary skill of art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)(emphasis added).

Here, by the Examiner's own admission, the cited reference does not teach or suggest all of the limitations of Applicant's claim 15. Accordingly, the Examiner has not established *prima facie* obviousness with respect to claim 15.

Further, the Examiner's suggestion that the presence of gravity could be utilized to aid in the clamping of a test strip and a factor in positioning the clamping mechanism is not supported in the Meinecke reference. Moreover, Applicant's claim 15 recites a clamping arm biased toward the support surface as set forth in the disclosure. Thus, gravity is not required in the claimed structure for clamping a test strip.

Additionally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d

1430 (Fed. Cir. 1990). The level of skill in the art cannot be relied on to provide the suggestion to combine the references. Al-Site Corp. v. VSI Int'l, Inc., F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Here, there is no suggestion in the Meinecke reference to provide a pivotal clamping lever overlying the support surface. Additionally, the Examiner has improperly relied on the level of skill in the art to provide a motivation to modify the Meinecke reference. Thus, the Examiner has not established a prima facie case obviousness under 35 U.S.C. § 103(a) with respect to claim 15.

Accordingly, for at least the above-identified reasons, claim 15 is not obvious under 35 U.S.C. § 103(a) over Meinecke and therefore, the rejection of claim 15 should be withdrawn.

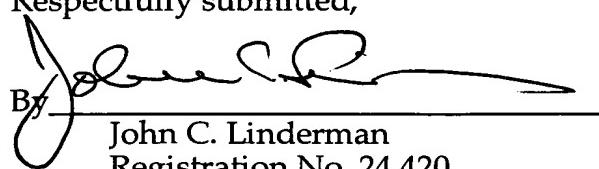
Claims 16, 17, 19 and 20 depend directly from claim 15 and also recite additional limitations. Since claim 15 is not obvious over Meinecke, for at least the above-identified reasons, dependent claims 16, 17, 19 and 20 are also not obvious over Meinecke. Therefore, the rejection of claims 16, 17, 19 and 20 under 35 U.S.C. § 103(a) should also be withdrawn.

Conclusion

In view of the foregoing, it is respectfully submitted that claims 11-17, 19 and 20 are allowable. All issues raised by the Examiner having been addressed herein, an early action to that effect is earnestly solicited.

Applicants believe no fee is due for this Response, however, should there be any deficiency in fees associated with the filing of this Response, please charge our Deposit Account No. 13-0235.

Respectfully submitted,

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